



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,832	03/17/2004	James G. Francis	1330.1020C	3139
21171 7590 05/06/2010 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
PATEL, JAGDISH				
ART UNIT		PAPER NUMBER		
3693				
MAIL DATE		DELIVERY MODE		
05/06/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/801,832

**Applicant(s)**

FRANCIS ET AL.

**Examiner**

JAGDISH N. PATEL

**Art Unit**

3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 7-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in response to amendment filed 1/28/10.

***Response to Amendment***

2. Claims 1,2,4, 7and 8 have been amended. Claims 1, 2, 4, 5, 7-10 and 12-16 remain under examination.

***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but the amended claims do not resolve the issues raised in the office action dated 7/28/09. The examiner notes that no persuasive arguments are presented which address the rejection claims under 35 USC 112(second).
4. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the (amended) claims would be understood by those skilled in the art in light of the specification.
5. The applicant argues that the rejection is unfair because the rejections were not previously raised. However, the examiner notes that the rejection should have been raised in earlier Office Action. This is not convincing in light of the fact that claims have been now amended and sufficient issues of indefiniteness have been raised to warrant the rejection. Citing

In re Zletz 13 USPQ2d 1320 (Fed. Cir. 1989) "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed..." and citing *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

[See 112(second) rejection with detailed explanation in the following section.]

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2, 4-5, 7-10 and 11-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. For clarity and convenience the amended claim 1 is reproduced herein and corresponding appropriate 112(second) analysis is provided alongside.

Claim 1 recites:

automatically assigning work items [corresponding to a trade commerce transaction financing and comprising issuances, advisements, amendments and payments, created by a computer in a customer service front office spoke] to work groups having workers at remote geographically dispersed locations across multiple time zones according to routing and distribution rules, [the work groups each having workers belonging to processing center hub back-offices having computers in different time zones to allow the work items to be handed off to workers within a work group as a first workday ends in one hub to workers within the work group in a second hub as a second workday begins];

This limitation is interpreted as being manually assigning the work items to work groups ..according to ..rules.

This renders the claim indefiniteness because human actions are subjective and abstract. Furthermore, no specific routing and distribution rules are defined that would enable a human to perform the assignment to work groups. Note that the portion of the claim limitation in brackets [] does not play any role in the assignment process.

This defect may be resolved by the assignment step is performed by a computer wherein the rules are accessed by the computer prior to automatically assigning the work items.

Now the processing step is addressed, which is stated as:

processing, using at least one computer having a processor, at a consolidated centralized hub processing location coupled to customer service spokes all the work items across multiple bank organizations, and consolidating back office processing of the work items in real-time with constant processing availability by using workflow routing between the remote locations as the remote locations become available for handling the work items and using a consolidated computer database in processing the work items, the database having multiple base currencies, each base currency corresponding to a country source of the transactions.

Herein the (at least one) computer at the centralized hub is not communicably connected to the (automatic assignment) entity. It is therefore, unclear how the assigned work items in the assigning step is received by the computer of the processing step. Furthermore, although the computer is located at a centralized hub processing location the customer service spokes, the processing step does not dependent on this coupling.

Furthermore, there is no indication in the claim that the work item assigned in the assigning step. Thus there is lack of proper antecedent basis in the claim.

The term "processing" is vague and indefinite without specifically pointing out actions are performed via the processing term [processing is interpreted working on or doing something using the work items] and thus rendered indefinite.

The claim fails to specify any particular reason or particular relational role of the remote locations in conjunction with the work orders processing. It is unclear whether all work items are processed at all remote locations concurrently. If this is the case the claim must recites that

the work items selected after the accessing are being distributed among the remote locations in succession.

The claim does not define remote locations [i.e. does not state that the “geographically dispersed” remote locations are predetermined before the processing of the work orders occurs] in order to facilitate the rollover. Furthermore the claim does not define the “roll over rules table” in terms of time line and the act of reassignment work [items] from one location to another location.

It is also asserted that the processing step is written in narrative form without specifically pointing out what particular function or functions are performed by the computer at the consolidated centralized hub processing location [centralized hub] and how [the computer at] the centralized hub interfaces with the remote locations. Furthermore the recitation that all the work items are processed across multiple bank organizations does not specifically point out what role the multiple bank play in processing the work items vis-à-vis the processing at the centralized hub. In other words the limitation fails to point out (i) how, when, where and what specific aspects of the work items are processed in terms of the specific locations and (ii) how real-time and constant processing of the work items is accomplished.

Furthermore, the two processing steps appear to be directed to same intended result with different work flow arrangement having no interrelationship thus the claim lacking clarity of the scope of the invention.

Furthermore, the term “processing” is intended to cover any thing and every thing concerning the finance work items including acts and items concerning the work items. Although

the providing access step describes the finance work items broadly, no further steps are recited that specifically point out the listed features of the work items including issuances, advertisements, amendments and payments and how these provisions of the work items are accomplished via the processing steps.

Furthermore, "to automatically rollover" is recited only as intended functional statement. It is unclear how this step is achieved.

Furthermore, it is unclear how the process of the method claim achieves the stated objective of "handling international trade financial transactions".

At least for the foregoing reasons, the examiner asserts that the claimed process is unclear, vague and indefinite failing to particularly point out the process of the method claim.

Claims 2, 4-5, 7-10 and 11-16 also contain deficiencies similar to those pertaining to claim outlined above. Additionally deficiencies specific to these claims are listed below where applicable.

Claim 2: fails to point out what the term "providing back office processing" means in the "providing back office processing" step. This step is interpreted as having established or arranged for "back office processing" and as such a manual process. The examiner asserts that the complex features of the back office processing is mere non-functional description since the relevant feature are stated in terms of functional process steps. It is suggested that this claim is redrafted such that the described computer databases and "at least one computer" are stated as positively interactive with the specific steps of work items processing.

Claim 4: see claim 2 analyses about (consolidated) database and at least one processor.



Claim 7: The claim is rendered indefinite since it does not positively state the outcome of the process step "initiating execution of a business object". The claim recites "initiating execution" of a business object but does not state the outcome of this step. Then it recites "handing the business object off to a second application server .." If the business object handed over same as the one whose execution was initiated. Note that a business object once executed must produce an outcome which may be a partially executed object. Is this partially executed object being handed?

Dependent claims 8-10 and 12-16 inherit deficiencies of claim 7 as outlined above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE **FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693